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To: A. Phi Dieu Tran
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 From: Mark Plager
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OCT 06 2005

1 **IN THE UNITED STATES PATENT & TRADEMARK OFFICE**
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910 Inventor: Thomas R. Herren) G.U.A.
11 Serial No.: 10/600,806) 3637
12 Title: Multipurpose Construction)
13 Assembly and Method)
14 Filed: 06/19/2003)
15 Examiner: A. Phi Dieu Tran)16
17 **RESPONSE TO DETAILED ACTION**
18 *Election / Restriction*19 Ass't Commissioner of Patents
P.O. Box 1450
20 Alexandria, Virginia 22313-1450

21 Sir:

22 In response to the September 15, 2005 Restriction of the above-referenced patent
23 application. The applicant finds the Office Action to be incomplete, non-informing, and
24 improper pursuant to § 707.07(d) of the Manual of Patent Examination Procedure. Section
25 707.07(d) states "where a claim is refused for any reason relation to the merits thereof it should
26 be 'rejected' and the ground of rejection fully and clearly stated . . ." M.P.E.P. §707.07(d). The
27 Examiner's restriction fails to "fully and clearly" identify which, if any, claims constitute "two or
28 more independent and distinct inventions."

Section 121 of the Patent Act provides that "[i]f two or more independent and distinct

1 inventions are claimed in one application, the Commissioner may require the application to be
2 restricted to one of the inventions.” 35 U.S.C. 121 (emphasis added). The Examiner’s
3 restriction is not predicated upon the claims of the pending application, but rather the figures.
4 Figures of a patent application do not define the scope of the applicant’s claimed invention. See
5 *Kaplan v. Robertson*, 50 F.2d 617, 620 (D.Md. 1931)(Description of invention as contained in
6 claims, interpreted in light of specifications, is to be neither restricted nor extended by drawings).
7 See, also, *Harvey Hubbell, Inc. v. General Electric Co.*, 267 F. 564, 570 (2d Cir. 1920). Rather,
8 the scope of the applicant’s invention is defined by the claims. See 35 U.S.C. 112 ¶ 2 (“The
9 specification shall conclude with one or more claims particularly pointing out and distinctly
10 claiming the subject matter which the applicant regards as his invention.”); See, also, *Ziegler v.*
11 *Phillips Petroleum Co.*, 483 F.2d 858, 869, 177 U.S.P.Q. 481 (5th Cir. 1973), *certiorari denied*,
12 94 S.Ct. 597, 414 U.S. 1079, 38 L.Ed.2d 485, 180 U.S.P.Q. 1 (Claims delineate scope of
13 protection afforded by a patent, not specific embodiments shown in patent drawings).
14 Consequently, the Examiner’s restriction is improper because it fails to identify which, if any,
15 claims support the existence of “two or more independent and distinct inventions” within the
16 subject application.

17 Applicant cannot respond to the September 15, 2005 Office Action because it fails to
18 provide “full and clear” identification of which, if any, claims constitute “two or more
19 independent and distinct inventions.” Accordingly, Applicant requests a restriction requirement,
20 if indeed one is required, which adequately provides a basis and rational, (i.e., the identification
21 of claims which constitute two or more independent and distinct inventions), which can be
22 reasonably addressed by means of a response. With respect to such a response, Applicant
23 requests a reasonable time period to prepare such a response.

Respectfully Submitted,

26 || October 5, 2005

Mark H. Plager, Reg. No. 35,648
Attorney for Applicant

1 PLEASE RESPOND TO:

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